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Filed : April 14, 2000

### REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider pending Claims 1-3, 5-9, 11-19, 22-33, and 35-55 of the above-captioned application in view of the foregoing amendments and the following remarks.

#### Claim Amendments

The foregoing amendments amend claims 1, 11, 12, 22, 27, 33, 37, and 46. No new subject matter is added by these amendments.

#### Claim Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-3, 5-6, 9, 11-13, 15-17, 33, and 35-36 under 35 U.S.C. 103(a) as being unpatentable over Rosen (US Patent No 6,493,677) in view of Dworkin (US Patent 4,992,940), in view of Guheen (US Patent 4,992,940), and further in view of Meltzer et al. (US Patent 6,125,391), hereinafter referred to as Meltzer. The Examiner also rejected claims 22-24 and 26 as being unpatentable over Rosen/Dworkin/Guheen/Meltzer and further in view of Lahey; rejected claims 7-8 as being unpatentable over Rosen/Dworkin/Guheen/Meltzer and further in view of the web pages "americangreetings.com" as available to the public on the internet on November 15, 1999, extracted from <http://www.archive.org> on 8/22/03; rejected claim 14 as being obvious over Rosen/Dworkin/Guheen/Meltzer and further in view of Official Notice; rejected claim 25 as being unpatentable over Rosen/Dworkin/Guheen/Lahey/Meltzer and further in view of americangreetings.com; rejected claims 27-30 and 32 as unpatentable over Rosen/Dworkin/Guheen and further in view of Lahey; rejected claims 37-41 and 46-51 as being unpatentable over Rosen/Dworkin/Guheen; rejected claims 45 and 55 as being unpatentable over Rosen/Dworkin/Guheen and further in view of Lahey; rejected claim 31 as unpatentable over Rosen/Dworkin/Guheen/Lahey and further in view of americangreetings.com; rejected claims 42-43 and 52-53 as being unpatentable over Rosen/Dworkin/Guheen and further in view of americangreetings.com; and rejected claims 44 and 54 as being obvious over Rosen/Dworkin/Guheen and further in view of Official Notice. Applicant traverses these rejections.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicant respectfully asserts that

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the cited prior art does not disclose or suggest all the limitations of the independent claims, nor provide a suggestion or motivation to modify the reference.

With respect to claim 1, the prior art does not teach all of the stated limitations. The prior art at least does not teach the claimed feature:

“...wherein the products database contains two or more products, and one or more products available in the products database are associated with manufacturing capabilities of two or more vendors capable of producing the product wherein said manufacturing capabilities comprise user contributed enhancement capabilities of the product;” (Claim 1).

Specifically, Applicant respectfully submits that the cited sections of Rosen do not teach or suggest “manufacturing capabilities of a *plurality of vendors capable of producing the products* available for personalization” as indicated in the Office Action in paragraph 4.1. There is no explicit disclosure in Rosen of providing a user with a *choice* between two or more products within a single implementation of the invention from a plurality of vendors, that the “product[] database contains two or more products” or that the “product[] available in the product[] database [is] associated with manufacturing capabilities of two or more manufacturers capable of producing the product” as claimed in claim 1. The cited limitations of claim 1 cannot be inferred from Rosen because the purpose of Rosen’s system is for “consumers [who are] likely to be interested in purchasing trademarked goods that can be customized to their specifications,” allowing a customer to configure a product with an assortment of configuration options to produce a particular branded product from a manufacturer. Rosen, col. 1, 44-46; *See e.g.*, Figs. 2, 3, 6. Applicant respectfully submits that Rosen also does not inherently describe the above-cited limitations of claim 1. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to support the determination that the inherent characteristic necessarily flows from the teachings of the applied prior art.” *See* M.P.E.P. § 2112. Applicant respectfully submits that the system and method described in Rosen (e.g., illustrated in Fig. 2) need not necessarily be used in conjunction with two or more vendors, is never described to be used with two or more vendors, and may in fact never be used with a plurality of vendors.

In Rosen, a user connects with a website located at one manufactures’ URL, “WWW browser 118 may be utilized to connect with a WWW site 166 located at the MYJONES.COM URL,” a single manufacturer. Rosen, col. 9, 1-3; Figure 6. Although Rosen teaches customizing a variety of product (e.g., tee-shirt, bottle) each from a single manufacturer, nowhere does Rosen disclose that its system is for anything other than customizing a single product and implemented for a single manufacturer. Because Rosen (or Dworkin, Guheen, Lahey, and Meltzer) do not teach or suggest the claimed feature listed above, and no other art is asserted as teaching this claimed feature, Applicant respectfully

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asserts claim 1, and independent claims 11, 22, 27, 33, 37, and 46 which also include inventive aspects of the claimed feature stated above, are in condition for allowance.

Further, the limitations of claim 1 are not obvious over Rosen in view of Dworkin. Applicant respectfully traverses the assertion in the Office Action that "Dworkin discloses a products database where one or more products are available and associated with manufacturing capabilities of two or more vendors capable of producing the product." Dworkin teaches a database that "may be the equivalent of thousands of catalogs of individual suppliers." Dworkin, col. 3, 67-68. In other words, it allows off-the-shelf shopping of numerous stores simultaneously via the Internet, and it naturally follows that the same products from the same manufacturers can be available from more than one vendor: "...it is preferable that each product, and each model within a product type, be obtainable from more than one supplier." Dworkin, col. 5, 25-27.

Dworkin's system selects an existing product having a particular specification from one of several sellers of the product:

"[t]he present system and method therefore enable a user to shop for products or services having particular specifications, and having the lowest price. The user does not need to consult the individual catalogs of suppliers, and can do all the shopping from a computer or terminal located virtually anywhere. The user can quickly and easily find the product or service having the lowest price, and having the required specifications." Dworkin col. 49-56.

While Dworkin may teach selecting a product from a collection of two or more products, it does so only in the context of a system where the selection is of an unmodifiable product sold as is by a vendor, in effect, merely selecting a product from a catalog. In other words, Dworkin discloses a system that "replaces a plurality of catalogs, and which greatly reduces the time required in shopping for products and services." Dworkin, col. 2, 63-65. In Dworkin, a product selection system uses a product's specifications to search for products meeting user entered criteria. The product selection taught in Dworkin has no capability for user contributed enhancements, but instead teaches a system for selecting off-the-shelf products in accordance with a predetermined specification.

Because product selection in Dworkin is for products having pre-defined specifications that cannot be enhanced by a user, the products in Dworkin are not "associated with manufacturing capabilities of two or more manufacturers capable of producing the product, *wherein said manufacturing capabilities comprise user contributed enhancement capabilities of the product*" (amended claim 1) as claimed in all the independent claims. Instead of manufacturing capabilities, Dworkin associates "products or services...[with] a desired set of *specifications*" that describe how the product is designed. Dworkin, col. 3, 50-51.

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Although useful in its own way, Dworkin's system is a substantially different concept and design than offering a selection of a customizable product that can be manufactured using manufacturing capabilities of two or more manufacturers as recited in the limitations of claim 1: "...products available in the products database are associated with *manufacturing capabilities* of two or more vendors." For at least these reasons, Applicant respectfully submits that neither Rosen nor Dworkin (nor the other cited art) teach or suggest at least the above-listed claimed feature.

Applicant also traverses the Examiner's assertion that "it would be obvious to a person of skill in the art at the time of the invention to modify Rosen [in view of Dworkin] to include the feature such that a products database includes information about one or more products and which are associated with manufacturing capabilities of two or more vendors, wherein said manufacturing capabilities comprise user added enhancement capabilities of the product."

First, as discussed above, neither Rosen or Dworkin teach or suggest this feature. Accordingly, combining features of the Rosen and Dworkin also does not teach or suggest this feature.

Second, the cited art fails to provide motivation to combine features of Dworkin and Rosen to teach the claimed invention of claim 1 as asserted in the Office Action because they disclose two systems which serve opposite purposes: one a system "equivalent to thousands of catalogs" selling unmodifiable products (Dworkin), and the other a system for creating a customized single product from a single vendor (Rosen). In fact, Dworkin teaches away from the customizable product system as recited in claim 1, instead disclosing a system that offers numerous products from thousands of catalogs and uses search criteria that facilitates a user to find "the [desired] product or service having the lowest price, and having the required specification" clearly not suggesting a need, or motivation, for customizing a product.

Lastly, Applicant respectfully submits that in the absence of a suggestion or motivation in any of the prior art, the assertion that modifying Rosen would be obvious to a person of skill in the art is impermissible hindsight unless a motivation or suggestion of the combination is explicitly disclosed in the art, and it is not.

Regarding Guheen, the prior art also including Guheen does not teach or suggest the stated limitation of claim 1 that

"said design tool is configured to constrain at least one configuration option available in said design interface *in response to a user selection of a product configuration option* so as to only allow the user to select further configurations and create individualized enhancements *such that the user selected configuration options and created enhancements are within the manufacturing capabilities retrieved from the database of at least one vendor of the said two or more vendors capable of producing the selected product.*"

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Guheen teaches a method by which the user may select the available features of the items to be purchased, after which the availability of the selected products possessing the selected features is determined. Guheen, Fig. 72. It does not teach a design tool which constrains user input of "configuration options and created enhancements" *in response to* a user selection of a product configuration option, nor does it teach a design tool that constrains product configuration options based on the capability to actually manufacture a device with the selected product configuration options.

Accordingly, Applicant respectfully asserts a prima facie case of obviousness cannot be established, and suggests Claim 1 is in condition for allowance for at least this reason, and submits claim 1 for further examination. The above-remarks pertaining to claim 1 also apply to the limitations of independent claims 11, 22, 27, 33, 37, and 46, as amended. Accordingly, Applicant respectfully asserts claims 11, 22, 27, 33, 37 and 46 are also in condition for allowance for at least the same reasons as claim 1, and submits claims 11, 22, 27, 33, 37 and 46 for further examination.

Claims 2-3, 5-9, 12-19, 23-32, 35-45, and 47-55, are dependant either directly or indirectly on claims 1, 11, 22, 27, 33, 37 and 46. Accordingly, Applicant respectfully asserts claims 2-3, 5-9, 12-19, 23-32, 35-45, and 47-55 are also in condition for allowance for at least the same reasons as independent claims 1, 11, 22, 27, 33, 37 and 46, and submits claims 2-3, 5-9, 12-19, 23-32, 35-45, and 47-55 for further examination.

### CONCLUSION

The applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes pursuant to statutory section 103, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as

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replacements or substitutes of any cancelled claims. They are simply additional specific statements of inventive concepts described in the application as originally filed.


If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned at (619) 687-8610.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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